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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,813	02/26/2002	Tracy Ann Willson	14730	6320

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EXAMINER

LANDSMAN, ROBERT S

ART UNIT PAPER NUMBER

1647

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/868,813

Applicant(s)

WILLSON ET AL.

Examiner

Robert Landsman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 1-19, 21, 22, 24 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Handwritten signature/initials.

DETAILED ACTION

1. Formal Matters

- A. The Amendment dated 5/18/05 has been entered into the record.
- B. Claims 1-25 are pending. Claims 1-19, 21, 22, 24 and 25 have been withdrawn as being drawn to a non-elected invention. Therefore, claims 20 and 23 are the subject of this Office Action.
- C. All Statutes under 35 USC not found in this Office Action can be found, cited in full, in a previous Office Action.

2. Specification

- A. The objection to the specification has been withdrawn in view of Applicants' submission of a new sequence listing and a statement stating that the paper copy and the computer copy of the sequence listing are the same and do not introduce new matter. Furthermore, the sequence "SPRY" has been identified by SEQ ID NO.
- B. The specification is objected to since the word "celluar" on page 27, line 24 is incorrect.
- C. The specification is objected to since the word "SCOS" on page 28, line 11 is incorrect.

3. Claim Rejections - 35 USC § 101

- A. The rejection of claims 20 and 23 under 35 USC 101 has been withdrawn in view of Applicants' arguments. While the function of the proteins which are to be degraded may not be known for all of the proteins, the invention focuses on the finding that the SOCS-box in proteins facilitates the presentation of proteins to the ubiquitination and/or proteasomal compartment. Therefore, the focus of the invention is directed toward the function of the SOCS-box and screening for compounds which affect this "general" mechanism, not on the function of the proteins which are or are not degraded.

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4. Claim Rejections - 35 USC § 112, first paragraph - enablement

A. The rejection of claims 20 and 23 under 35 USC 112, first paragraph, has been withdrawn in view of Applicants' demonstration that the present invention possesses utility. However, as seen below, a new rejection under 35 USC 112, first paragraph, has been made regarding the scope of the invention.

B. Claims 20 and 23 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for methods of identifying agents which inhibit degradation of proteins which possess a SOCS-box (i.e. "SOCS-box-containing proteins"), does not reasonably provide enablement for a methods of identifying agents which inhibit the degradation of any protein without a SOCS-box, or simply associated with a SOCS-box, or protein containing a SOCS-box. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

As written, the breadth of the claims is excessive with regard to Applicants claiming methods of identifying agents which inhibit degradation of proteins which do not possess a SOCS-box (i.e. "SOCS-box-containing proteins"). Applicants have only provided guidance and working examples of performing these screening methods with proteins which actually contain a SOCS-box. As written, the proteins which are degraded can be any protein. It is not predictable to the artisan what proteins other than those containing a SOCS-box of SEQ ID NO:4 would be affected by inhibiting the SOCS-box/elongin interaction.

Therefore, the breadth of the claims is excessive regarding Applicants claiming methods of identifying agents which inhibit degradation of proteins other than those containing a SOCS-box. Applicants have only provided guidance and working examples of performing these screening methods with proteins which contain a SOCS-box. It is not predictable to the artisan what proteins other than those containing a SOCS-box of SEQ ID NO:4 would be affected by inhibiting the SOCS-box/elongin interaction. For these reasons, the Examiner holds that undue experimentation is required to practice the invention as claimed.

5. Claim Rejections - 35 USC § 112, second paragraph

A. The rejection of claim 23 under 35 USC 112, second paragraph, has been withdrawn in view of Applicants' amendment to the claim to add "SEQ ID NO:4."

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B. The rejection of claim 20 under 35 USC 112, second paragraph, has been withdrawn in view of Applicants' amendment to the claim to recite "inhibits."

C. Claims 20 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite screening for "agents." However, other than the preamble, there are no method steps which discuss, or identify, "agents." The claims only recite "candidate molecules" and "selecting molecules."

D. Claims 20 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: a conclusion step which determines when the artisan has identified an agent which inhibits or promotes protein degradation. "Selecting molecules which promotes/inhibit said interaction" does not conclude that an agent has been identified. Applicants may wish to amend the claims to recite, for example, "wherein a molecule which inhibits...would be considered an agent/molecule which promotes degradation."

6. Claim Rejections - 35 USC § 102

A. The rejection of claims 20 and 23 under 35 USC 102 has been withdrawn in view of Applicants' arguments that Kamura et al. teach the opposite of what has been discovered by the present invention.

7. Claim Rejections - 35 USC § 103

A. The rejection of claims 20 and 23 under 35 USC 103 has been withdrawn in view of Applicants' arguments that Kamura et al. teach the opposite of what has been discovered by the present invention.

8. Conclusion

A. No claim is allowable.

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Advisory information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Landsman whose telephone number is (571) 272-0888. The examiner can normally be reached on M-Th 10 AM – 7 PM (eastern); alt F 10 AM – 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on 571-272-0961. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert Landsman
Primary Examiner
Art Unit 1647


ROBERT S. LANDSMAN, PH.D
PRIMARY EXAMINER